# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/022,909 | 12/20/2001 | Yoko Yamaga | P67437US0 | 2112 |

| | | EXAMINER |
|---|---|---|
| 7590 04/19/2006 | | SHANG, ANNAN Q |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2623 | |

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
| **Office Action Summary** | 10/022,909 | YAMAGA, YOKO |
| | Examiner | Art Unit | |
| | Annan Q. Shang | 2623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>20 December 2001</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1.      Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. In claim 9, line 19 the phrase "stored in a memory of

the sub-server the order server" should be changed. It is not clear which memory (the

sub-server or order terminal, the sub-server and/or the order terminal) is being referred

to.

### *Claim Rejections - 35 USC § 102*

2.      The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office

action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.      Claims 1-3, 6-8 and 13-15, are rejected under 35 U.S.C. 102(e) as being

anticipated by **Yukie et al (6,956,833).**

As to claim 1, note the **Yukie** reference figures 1-2, discloses method, system

and devices for wireless data storage on a server and data retrieval and further

discloses a digital content-data distribution system comprising:

An other terminal (User Device 'UD' 10, fig.1 and col.3, lines 29-55) for downloading digital content data in response to order placement made by a user for the digital content data via the order terminal (col.4, lines 1-22), whether the ordered digital content data be downloaded when the user request places an order or later being decided in accordance with a user request and/or capacity of the user memory for storing the ordered digital content data (col.4, lines 1-22, lines 40-63, col.6, lines 19-53 and col.17, line 7-col.18, line 7); and

a main server (Data Sever 'DS' 16) for transmitting the ordered digital content data when the user places an order or later in accordance with the decision (col.17, line 7-col.18, line 7), note that UD-10 can use local storage media 32 as primary storage and data server 16 as secondary storage and vice-versa depending on the storage capacity of the local storage.

As to claim 2, Yukie further discloses a sub-terminal, the ordered digital content data (ODCD) being downloaded to the order terminal for downloading at the order placement whereas being downloaded to the order terminal or the sub-terminal for downloading later (co.4, lines 4-22, col.9, lines 7-47 and col.11, lines 61-col.12, line 13).

As to claim 3, Yukie further discloses where the ODCD is downloaded to the user memory at the order placement while digital content data already stored in the user memory is transferred to a memory of the main server when the user memory lacks capacity for the data to be downloaded (col.6, lines 44-53, col.7, lines 36-55, col.15, lines 32-41 and col.17, lines 31-53).

As to claims 6-7, Yukie further discloses where the main server has a transmitter for transmitting the ODCD, the system further comprising a sub-server connected to the main server via a network and a sub-terminal to which the ODCD is downloaded, where the sub-server has a first receiver for receiving the digital content data transmitted by the first transmitter of the main server, a memory for storing the received digital content data and a second transmitter for transmitting the ordered digital content data to the sub-terminal; and where the sub-terminal has a second receiver for receiving the ordered digital content data transmitted from the sub-server and a memory for storing the downloaded digital content data (figs.1, 3, col.5, line 39-col.6, line 3 and col.8, line 66-col.9, line 35).

As to claim 8, Yukie further discloses where the main server has a processor for designating a place to which a storage medium storing the digital content data ordered from the order terminal to the main server and/or goods related to the ordered digital content data are/is to be delivered, the system further comprising a delivery server connected to the main server via network, the delivery server having: an order-accepting unit for accepting an order for the storage medium and/or goods; a stock-managing unit for managing stock and a date of delivery for the ordered storage medium and/or goods and notifying the order-accepting unit of information on the stock and date of delivery; and a delivery unit for delivering the ordered storage medium and/or goods to place designated by the processor of the main server in response to the information sent from the order-accepting unit (col.5, line 39-col.6, line 3, col.17, lines 7-37, line 54-col.18, line 20, line 36-col.19, line 40).

As to claim 13, the claimed "a method of distributing digital content data via communications between an order terminal and a main server..." is composed of the same structural elements that were discussed with respect to the rejection of claim 1.

Claim 14 is met as previously discussed with respect to claim 2.

Claim 15 is met as previously discussed with respect to claim 3.

## *Claim Rejections - 35 USC § 103*

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.      Claims 9 and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yukie et al (6,956,833)** as applied to claims 1 and 13 above, and in view of **Ogino (6,449,425).**

As to claim 9, Yukie further discloses where the main server has a copyright-information adder for adding copyright-information to the digital content data (col.13, lines 1-22),

The system further comprising:

A sub-server (Data Server 'DS2' 46, fig.2), connected to the main server (Data Server 'DS' 40) via a network (Network-42 or Internet 22), for receiving the digital content data transmitted from the main server (col.5, lines 39-60); and

A sub-terminal (Terminal 'T' 26) for receiving the digital content data transmitted from the main server or the sub-server (col.4, lines 23-39),

Where the sub-server includes: A first receiver for receiving the digital content data transmitted from the main server and where the sub-terminal includes a second receiver for receiving the digital content transmitted from the server or sub-server (col.4, lines 23-39 and col.5, lines 39-60).

Yukie fails to explicitly teach a copyright-information manager for deciding whether or not the digital content data received by the first receiver has been added the copyright-information and copyright-information deleter for deleting the digital content data or making the digital content data as un-reproducible when a duplicate of the digital content data is stored in a memory of the order terminal.

However, note the **Ogino** reference figures 1-3, discloses information signal output control method, information signal duplication prevention method and device for controlling signal recording medium to prevent duplication of received digital content (col.6, line 63-col.8, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Ogino into the system of Yukie to prevent a user from making multiple copies of the digital content.

Claim 12 is met as previously discussed with respect to claim 9.

Claim 19 is met as previously discussed with respect to claim 9.

Claim 23 is met as previously discussed with respect to claim 9.

6.      Claims 4-5, 10-11, 16-17, 20-22 are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Yukie et al (6,956,833)** in view of **Agraharam et al**

**(6,035,339)**

As to claims 4-5, Yukie teaches all the claimed limitations as previously

discussed with respect to claim 1 above, but fails to explicitly teach where the ordered

digital content data transmitted by the main server has several data formats, data

formats reproducible by the order terminal only being displayed on the order terminal

and where the format is decided in response to entry of a name of the user player for

reproducing the ordered the ordered digital content data.

However, note the **Agraharam** reference figures 1-5, discloses network

information delivery system (fig.1 and col.2, lines 26-51) for delivering information based

on end user terminal requirements (fig.2), where a server stores two or more number of

digital content data having the same contents but different from each other on

compression ration and/or data format (col.3, lines 5-46, line 64-col.4, line 13 and lines

23-57).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to incorporate the teaching of Agraharam into the system of Yukie in

order to format content based on each user's device and provide services to various

types of devices.

As to claim 10, the **Yukie** reference figures 1-2, discloses a method, system and

devices for wireless data storage on a server and data retrieval and further discloses a

digital content-data distribution system comprising:

An order terminal (User Device 'UD' 10) for downloading digital content data when the user places an order for digital content data via the order terminal; and

A main server (Data Server 'DS' 16) for transmitting the ordered digital content data in response to the order placement via the order terminal,

Where the main server includes:

A memory (Mass storage of DS-16, fig.4 and col.21, lines 34-62) for storing a number of digital content data (multimedia, col.4, lines 1-22) of different forms and compressing the multimedia in different format base on the device capabilities (col.6, line 19-23. line 67-col.7, line 3 and lines52-55) and includes an order accepting unit (Central Processor 'CPU' 104) for accepting the order placement for the digital content data; a data-retrieving unit, a data-receiver designating unit and media-selecting unit (CPU-104 or Host Adapter 'HA' 122), responsive to the order placement, for retrieving the digital content data from the memory; for designating a receiver for receiving the digital content and for selecting package media and/or downloadable digital-data media for obtaining the ordered digital content data; and

a transmitter for transmitting (Network Interface 130, col.21, lines 34-62) for transmitting the digital content data as the downloadable digital-data media to the order terminal (UD-10) or a sub-terminal (T-26) when designated as the receiver;

the order terminal includes: an order-placing unit for placing an order for the package media and/or the downloadable digital-data media to the main server; and

a receiver for receiving the downloadable digital-data media (col.4, lines 1-45, col.6, lines 19-43 and col.11, line 31-col.12, line 13),

the system further comprises a delivery server connected to the main server via

a network, the delivery server having: a communication unit for receiving an order

placement from the main server; an order-accepting unit for accepting an order for the

storage media (col.11, line 31-col.12, line 13, col.13, lines 1-22, col.17, line 7-col.18,

line 1+)

a stock-managing unit for managing stock and a date of delivery for the ordered

storage media and notifying the order-accepting unit of information on the stock and

date of delivery; and a delivery unit for delivering the ordered storage media to place

designated the order-accepting unit (col.17, line 7-col.18, line 1+ and col.19, line 7-40),

and

the sub-terminal being connected to the main server via the network, having a

receiver for receiving the downloadable digital-data media (col.4, lines 23-39).

Yukie, fails to explicitly teach storing two or more number of digital content data

having the same contents but different from each other on compression ratio and/or

data format.

However, note the **Agraharam** reference figures 1-5, discloses network

information delivery system (fig.1 and col.2, lines 26-51) for delivering information based

on end user terminal requirements (fig.2), where a server stores two or more number of

digital content data having the same contents but different from each other on

compression ration and/or data format (col.3, lines 5-46, line 64-col.4, line 13 and lines

23-57).

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to incorporate the teaching of Agraharam into the system of Yukie in

order to format content based on each user's device and provide services to various

types of device.

As to claim 11, Yukie further discloses where the main server further includes:

A memory for storing a player database of names of players for reproducing the

digital content data and data formats reproducible by the players; where the order

terminal and the sub-terminal include: an entry unit for entering a name of a player for

reproducing the digital content data; A communications unit for transmitting the name of

the player to the main server and receiving the information on the retrieved reproducible

data (col.6, lines 19-53 and col.17, line 7-col.18, line 1+); the claimed "formats..." is met

as previously discussed with respect to claim 10.

Claims 16-17 are met as previously discussed with respect to claim 4-5.

As to claims 20-21, the claimed "a method of distributing digital content data via

communications between an order terminal and a main server..." is composed of the

same structural elements that were discussed with respect to the rejection of claim 10.

Claim 22 is met as previously discussed with respect to claim 11.


7.     Claims 12 and 23, are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Yukie et al (6,956,833)** in view of **Agraharam et al (6,035,339)** as

applied to claims 10 and 20 above and further in view of **Ogino (6,449,425)**

As to claim 12, Yukie as modified by Agraharam, fail to explicitly teaches sub-server and sub-terminal as previously discussed with respect to claim 9 above, but fails to explicitly teach monitoring duplication.

However, **Ogino** discloses information signal output control method, information signal duplication prevention method and device for controlling signal-recording medium to prevent duplication of received digital content (col.6, line 63-col.8, line 1+).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Ogino into the system of Yukie as modified by Agraharam to prevent a user from making multiple copies of the digital content.

Claim 23 is met as previously discussed with respect to claim 12.

### *Conclusion*

8.     The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sahai et al (6,594,699) disclose system for capability based multimedia streaming over a network.
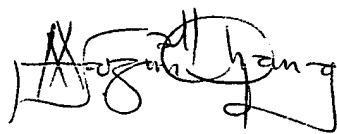
Mattis et al (6,289,358) disclose delivery alternate versions of objects from an object cache.

Potu et al (5,812,144) disclose system for performing real-time video resizing in a data processing system having multimedia capability.

9.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

**Annan Q. Shang**